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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,107	02/13/2001	Mihal Lazaridis	1400-1072D1	3129

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EXAMINER

STRANGE, AARON N

ART UNIT	PAPER NUMBER
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2448

NOTIFICATION DATE	DELIVERY MODE
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08/02/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	09/782,107	LAZARIDIS ET AL.	
	Examiner	Art Unit	
	AARON STRANGE	2448	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 90-95,97-102 and 105-108 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 91-95,97 and 98 is/are allowed.
- 6) ☒ Claim(s) 10,90,99 and 105-108 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20110310;20110519</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pp.12-14, filed 5/16/2011, with respect to the rejection of claims 90-95, 97-102 and 105-108 under 35 U.S.C. §103(a) have been fully considered and are persuasive. In particular, the Examiner agrees with the BPAI's rejection of its' prior interpretation of Eggleston, as set forth in Appeal No. 2003-2074. Accordingly, that rejection has been withdrawn.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 90, 99 and 105 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,389,457. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-12 of U.S. Patent No. 6,389,457 contain each element of claims 90, 99 and 105.

For example, claim 1 of U.S. Patent No. 6,389,457 contains limitations directed to receiving a data item at a host system, copying the data item, sending the copy to a mobile communication device and processing reply mail items so they share the same address as items generated at the host system. Claims 3-5 of U.S. Patent No. 6,389,457 contains limitations directed to encrypting the data items and reply mail items and packaging the mail items in electronic envelopes. Collectively, these claims contain all of the principal features of claims 90, 99 and 105 of the present application.

The Examiner believes that the correspondence between claims 90, 99 and 105 of the present application and claims 1-12 of U.S. Patent No. 6,389,457 is apparent from reading the claims. However, if Applicant has any questions regarding this rejection, he/she is encouraged to contact the Examiner for clarification.

4. Claims 90, 99 and 105 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 6,401,113. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-34 of U.S. Patent No. 6,401,113 contain each element of claims 90, 99 and 105.

For example, claim 1 of U.S. Patent No. 6,401,113 contains limitations directed to receiving a redirected data item at a mobile device and generating reply mail items so they use the address of the host system as an originating address. Claims 5-6 of U.S. Patent No. 6,401,113 contains limitations directed to packaging the redirected mail items in electronic envelopes and generating an indication of receipt of a new mail item for redirection. Claim 13 of U.S. Patent No. 6,401,113 contains limitations directed to encrypting the mail items. Collectively, these claims contain all of the principal features of claims 90, 99 and 105 of the present application.

The Examiner believes that the correspondence between claims 90, 99 and 105 of the present application and claims 1-34 of U.S. Patent No. 6,401,113 is apparent from reading the claims. However, if Applicant has any questions regarding this rejection, he/she is encouraged to contact the Examiner for clarification.

5. Claims 90, 99 and 105 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 6,219,694 in view of Murota (US 6,289,105).

6. Claims 90, 99 and 105 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 6,219,694. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-36 of U.S. Patent No. 6,219,694 contain each element of claims 90, 99 and 105.

For example, claim 1 of U.S. Patent No. 6,219,694 contains limitations directed to receiving messages and redirecting them to a mobile communication device and generating reply mail items so they use the address of the host system as an originating address. Claims 7 of U.S. Patent No. 6,219,694 contains limitations directed to packaging the redirected mail items in electronic envelopes. Collectively, these claims contain all of the principal features of claims 90, 99 and 105 of the present application except encrypting the mail items, which was old and well known in the art, as shown by Murota (US 6,289,105).

Murota discloses a similar system for sending e-mail messages between a sender and a receiver, wherein a message is encrypted at the sending end, is then transmitted over the network to the receiving end, and is finally decrypted at the receiving computer (col. 1, ll. 23-48). Murota further discloses that such an encryption

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scheme is advantageous because it prevents leaks of secret information to outside, non-intended parties (Murota, col. 1, ll. 49-53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to encrypt the data items to prevent unauthorized parties from accessing the contents of the data items.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 105-108 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. Claim 105 is directed to a “computer-accessible medium”, a term not defined by the specification. The broadest reasonable interpretation of a claim drawn to a machine readable medium, or other such variations, covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable medium. When the broadest reasonable interpretation of a claim covers a signal *per se*, the claim must be rejected under 35 U.S.C. §101 as covering non-statutory subject matter. *See In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter).

The Examiner recommends amending claim 105 to add the limitation "non-transitory" to overcome the above rejection.

10. All claims not individually rejected are rejected by virtue of their dependency from the above claims and their failure to correct the above noted deficiencies.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 99-102 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Regarding claim 99, the claim elements "means for receiving an indication", "means for processing a copy of the mail item", "means for causing", "means for receiving an encrypted reply mail item" and "means for interfacing the reply mail item", are each means (or step) plus function limitations that invoke 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed functions.

The specification appears to describe that the functionality of the claimed means is performed by "redirector software 12" (See e.g., pp. 15-18) which is "operating at the user's PC" (see ¶26 of the specification amendment filed 5/1/2008).

Therefore, it appears that the specification discloses only a "general purpose computer" (the user's PC) running a "redirector program", without including a description of the algorithm that transforms the user's PC into a special purpose computer programmed to perform the claimed functions. Applicant may express the algorithm in any understandable terms including a mathematical formula, in prose, in a flow chart, or in any other manner that provides sufficient structure. *See Finisar Corp. v. The DIRECTV Group Inc.*, 523 F.3d 1323, 1340 (Fed Cir. 2008).

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)) or relying on documents incorporated by reference.

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

14. All claims not individually rejected are rejected by virtue of their dependency from the above claims.

Allowable Subject Matter

15. Claims 90-95, 97 and 98 are allowable over the prior art of record, but claim 90 remains subject to the double patenting rejections set forth above.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Strange/
Primary Examiner, Art Unit 2448